

## Practitioner's Docket No. 408445

**REMARKS**

Claims 1-20 are pending in the application. Claim 1 is currently amended.

Claim 1 is amended to recite that the two direct repeats of a gene of interest are "effective for" recombination with the genome of the host cells. This is a different way of stating what was intended by the last amendment. It is the crux of the position asserted by the Office that any DNA is "capable of recombination" (because any DNA may recombine) and so the Office takes the view that the former claims do not distinguish Bauer et al. We take exception to that view of Bauer because Bauer in column 6 at lines 52-67 specifically provides that the DRS thereof are not repeat not recombogenic with the host genome. With all due respect, the full text of the relevant limitation that the Office should have considered was that the direct repeats are "capable of recombination *with the genome of the host cells* [emphasis added]. Since this is primarily a semantic dispute, we have amended to say that the direct repeats are "effective for." What is meant by this is that the direct repeats are effective for recombination with the genome of the host cells, and this is directly the opposite of what Bauer et al. teaches.

Claims 1 and 4 stand rejected under 35 U.S.C. §102(e) as being anticipated by Bauer et al. This is not the case where Bauer et al. teaches that the DRS thereof are not capable of recombination with the host genome, and so we respectfully submit that these claims are not anticipated and should be allowed.

Claims 1, 6, 10, 12, 14 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bauer et al. We respectfully traverse. The Office takes the position that a *prima facie* case is of record and that Applicant is reading limitations into the claims to suggest that there is any different scope of the claims other than the inclusion of positive and negative selectable markers. The position of the Office is the result of the semantic dispute that has been rectified by the amendment discussed above. There is no *prima facie* case and no motivation where Bauer et al. specifically teaches away from what is claimed. Specifically, Bauer et al. teaches that the DRS thereof are nonrecombogenic, and we claim that they are. This provides the numerous advantages discussed in our last response, and the distinction is not a trivial one.

Applicant wishes to thank the Examiner for the indication that claims 2, 3, 5, 7-9, 11, 13, 16 19 and 20 would be allowable if rewritten in independent form; however, it appears that a broad scope of coverage is in order for the reasons explained above.

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Based upon the foregoing discussion, Applicant's attorney submits that the amended claims are allowable and respectfully solicits a Notice of Allowance. The Commissioner is authorized to charge any additionally required fees to deposit account 12-0600.

Respectfully submitted,

**Lathrop & Gage, L.C.**  
Attorneys for Applicant:



Dan Cleveland, Jr., Reg. No. 36,106  
4845 Pearl East Circle, Suite 300  
Boulder, CO 80301  
Phone: (720) 931-3012  
Fax: (720) 931-3001

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